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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,699	08/31/2001	Akinori Iwase	016907-1275	9335
22428	7590	12/02/2004	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			GOLD, AVI M	
			ART UNIT	PAPER NUMBER
			2157	

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/942,699

Applicant(s)

IWASE ET AL.

Examiner

Avi Gold

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/16/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to the application filed August 31, 2001. Claims 1-13 are pending. Claims 1-13 represent server apparatus and network system.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Singhal, U.S. Patent No. 6,256,666.

Singhal teaches the invention as claimed including a method and system by which a user may use a low-capability device to direct a software agent to process and deliver large or complex documents embedded inside an electronic mail document (see abstract).

Regarding claims 1, 4, 5, 6, and 7, Singhal teaches a server apparatus in which a groupware is operated, comprising:

a memory to store data (col. 3, lines 33-35, Singhal discloses memory of a storage device on a LAN);

an interface configured to transmit data to a mobile terminal (col. 4, lines 31-35, Singhal discloses a Mobile Access Gateway and Mobile Access Network); and

a controller configured to form data for transmission to the mobile terminal and separately manage the thus formed data for transmission and data among data addressed to the mobile terminal which is not transmitted to the mobile terminal and is stored in said memory when the data addressed to the mobile terminal is transmitted to the mobile terminal via said interface (col. 4, lines 24-29, Singhal discloses the Mobile Access Gateway program applying transformation logic to an email and, col. 5, lines 54-57, attachments stored in the email server's memory).

Regarding claim 2, Singhal teaches the server apparatus according to claim 1, the data for transmission to the mobile terminal formed by said controller includes information indicating the contents of the data addressed to the mobile terminal and information indicating the presence of data which is not transmitted yet and is associated with the former information (col. 4, lines 26-31, Singhal discloses the Mobile Access Gateway summarizing a message and, col. 5, lines 8-16, the use of Attachment Control Messages encapsulated within email messages).

Regarding claim 3, Singhal teaches the server apparatus according to claim 1, the data for transmission to the mobile terminal formed by said controller includes text data and information indicating that file data attached to the text data is present and data stored in said memory is the file data attached to the text data in a case where the

data addressed to the mobile terminal includes the text data and the file data attached to the text data (col. 4, lines 24-35, col. 5, lines 8-16).

Regarding claim 8, Singhal teaches the network system according to claim 7, the controller of said first apparatus transmits information indicating a storage location together with the storage data to said second apparatus via the second interface and the storage data is stored in a storage location of the memory of said second apparatus based on information indicating the storage location and received from said first apparatus (col. 4, lines 25-35, col. 5, lines 8-16, 54-57).

Regarding claim 9, Singhal teaches a server apparatus in which a groupware is operated, comprising:

- a memory to store data (col. 3, lines 33-35);

- an interface configured to transmit data to a mobile terminal (col. 4, lines 31-35);

and

- a controller configured to manage an electronic mail in the groupware and form a text of the electronic mail for transmission to the mobile terminal if file data attached to the electronic mail addressed to the mobile terminal exists and separately managing the thus formed text of the electronic mail and attached file (col. 4, lines 21-29, col. 5, lines 54-57).

Regarding claim 10, Singhal teaches the server apparatus according to claim 9, the data for transmission to the mobile terminal formed by said controller includes information indicating a text of the electronic mail and information indicating that file data attached to the electronic mail is present and data stored in said memory is the file data attached to the text data in a case where the electronic mail addressed to the mobile terminal includes the text and the file data attached to the text (col. 4, lines 25-35, col. 5, lines 8-16).

Regarding claim 11, Singhal teaches the server apparatus according to claim 9, said controller manages the electronic mail in the groupware, forms the text of the electronic mail for transmission to the mobile terminal if file data attached to the electronic mail addressed to the mobile terminal is present, transmits the thus formed text of the electronic mail to the mobile terminal via said interface and stores the attached file into said memory (col. 4, lines 24-29, col. 5, lines 8-16, 54-57).

Regarding claim 12, Singhal teaches the server apparatus according to claim 9, said controller manages the electronic mail in the groupware, forms the text of the electronic mail for transmission to the mobile terminal if file data attached to the electronic mail addressed to the mobile terminal is present, transmits the thus formed text of the electronic mail to the mobile terminal via said interface and stores the attached file into a previously set storage location (col. 4, lines 24-29, col. 5, lines 8-16, 54-57).

Regarding claim 13, Singhal teaches the server apparatus according to claim 9, said controller manages the electronic mail in the groupware, forms the text of the electronic mail for transmission to the mobile terminal if file data attached to the electronic mail addressed to the mobile terminal is present, transmits the thus formed text of the electronic mail to the mobile terminal via said interface and stores the attached file into said memory according to an instruction from the mobile terminal (col. 4, lines 24-29, col. 5, lines 8-16, 54-57).

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 6,714,133 to Hum et al.

U.S. Pat. No. 6,801,962 to Taniguchi et al.

U.S. Pat. No. 6,434,405 to Sashihara

U.S. Pat. No. 6,690,950 to Takagi et al.

U.S. Pat. No. 6,198,783 to Campana, Jr.

U.S. Pat. No. 6,782,419 to Tobita et al.

U.S. Pat. No. 6,304,898 to Shiigi

U.S. Pat. No. 6,157,945 to Balma et al.

U.S. Pat. No. 6,798,715 to Kubo et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Avi Gold whose telephone number is 571-272-4002.

The examiner can normally be reached on M-F 8:00-5:30 (1st Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Avi Gold

Patent Examiner

Art Unit 2157

AMG



SALEH NAJJAR
PRIMARY EXAMINER